



UNITED STATES PATENT AND TRADEMARK OFFICE

Examiner:

Art Unit: 1762

In re:

Applicant: MAGDINA, et al

Serial No.: 10/650,664

Filed: 08/29/2003

DECLARATION OF UNOBVIOUSNESS UNDER RULE 231

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04/18/04

ILYA ZBOROVSKY

Commissioner for Patents
P. O. Box 1450
Alexandria, Virginia

Sir:

I, **DENNIS SONGHURST**, am a Senior Surface Coatings
Technologist with extensive experience in the management and sales of
chemical products.

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As a Paint Chemist, I have held several positions in both the U.K. (Blundell Permoglaze) and Canada (General Paint, Reichhold Chemicals) including Development Chemist, Team Leader, Technical Service Manager and Technical Service Manager and Technical Service Coordinator. As a Sales Professional with Reichhold Chemicals I was the Account Executive responsible for direct accounts in Western Canada and agent accounts in the Pacific Northwest.

I attend the Borough Polytechnic in London, England and was awarded the Full Technological Certificate in Paint Technology (FTC) by the City of Guilds of London Institute.

I have been granted Professional Membership in the Class of Associate in the Technology of Surface Coatings (ATSC) by the Oil & Colour Chemists Association.

I am also a member in the Oil & Colour Chemists Association (Ontario), the Pacific Northwest Society for Coatings Technology and a director of the British Columbia Paint Manufacturer's Association.

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I familiarized myself with a new inventions disclosed in U.S. patent application serial no. 10/650,664 filed on August 29, 2003 with the United States Patent and Trademark Office and also with U.S. patent no. 6,251,961 issued to Pirag, et al for flame-retardant coating. I compared the solutions proposed in the patent application and in the patent with one another. In connection with this, I wish to make the following remarks.

Claim 1 of the application defines a method of painting a surface in predetermined color which includes the steps of providing a paint including a film-forming binder component for forming a film of the paint on the surface, a color-producing component for providing the predetermined color on the surface, and a fire-retardant component adapted to protect the surface from consequences of fire; and painting the surface with said paint so as to impart the predetermined color to the surface and also to protect the surface from fire.

The patent discloses a flame-retardant coating which forms an insulating layer and is based on substances which carbonize and form a foam layer in the event of a fire. As an expert in the field of paints, I believe that the solution disclosed in the reference deals exclusively with

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application of a flame-retardant coating on a corresponding surface and has nothing to do with the method of painting a surface and predetermined color in accordance with the present invention. In the reference the surface is not painted with a paint, but instead is covered with a coating. In the reference the surface is not painted with a paint to impart a predetermined color to the surface, but instead the surface is covered to protect it from fire exclusively. I firmly believe that for a person skilled in the art these two solutions are completely different and can not be compared with one another. It is therefore my opinion that a method of painting a surface in a predetermined color as defined in claim 1 of the present application clearly and patentably distinguishes the present invention from the prior art represented by the patent.

Claim 9 defines a paint for painting a surface in a predetermined color, which includes film-forming binder component for forming a film of the paint on the surface; a color-producing component for providing the predetermined color on the surface; and a fire-retardant component adapted to protect the surface from consequences of fire, such that when a surface is painted with the paint, the predetermined color is imparted to the surface and the surface is protected from fire, while claim

24 defines a method for producing a paint for painting a surface in a predetermined color which includes the steps of mixing a film-forming binder component for forming a film of the paint on the surface, and a color-producing component for providing the predetermined color on the surface; and adding a fire-retardant component adapted to protect the surface from consequences of fire, so that when a surface is painted with the thusly produced paint, the predetermined color is imparted to the surface and the surface is protected from fire.

The patent has nothing to do with paints for painting a surface in a predetermined color and it has nothing to do with a method for producing paints for painting a surface in a predetermined color. It is therefore my opinion that the paint disclosed in the patent application as well as the method for producing the paint are also completely different from the coating and the method of producing the coating disclosed in the patent. As a person skilled in the art of paints, it is my opinion that neither me nor my colleagues would look for solutions in the area of fire-retardant coatings for a new paint for painting a surface in a predetermined color and for a new method of producing of such paints. Thus, in my opinion

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claims 9 and 24 clearly and patentably distinguish this invention from the prior art.

Claim 5 defines that in a method of painting in accordance with the present invention, the painting is performed with a paint which includes in addition to a color-producing component, also a fire-retardant component which does not include 15 weight % of the paint. Claim 13 deals with a paint which includes this feature, and claim 28 defines a method of making a paint which includes this feature. The features of these three claims are exceptionally important and clearly and patentably distinguish the present invention from the prior art represented by the patent.

In the patent the coating disclosed in the reference includes a fire retardant part of the patent composed of Exolit, melamine polyphosphate and dipentaerythritol in all examples, which jointly form 53 weight % in Example 2, 61 weight % in Example 4, and 58 weight % in Example 6. This represents a tremendous difference between the coating in the patent and the paint of the present invention. If, for some unknown and highly improbable reasons, a person skilled in the art used such a fire

retardant part in a paint of the present invention or in any other paint, the paint would be completely compromised and it would no longer perform its functions as a paint for coloring a surface. The total composition of the paint would be completely distorted and the paint will no longer maintain its properties and will be no longer usable for painting surfaces in predetermined colors. Thus, it is believed to be clear that these claims also clearly and patentably distinguish the present invention from the prior art.

Finally, claims 8, 16, and 31 define that the paint has a filler, in the method of painting the paint with the filler is utilized, and in the method of producing the paint the filler is introduced into the paint. The provision of the filler clearly indicates that the product of the present invention is a paint and not a coating similar to the coating disclosed in the patent. The patent does not disclose any examples in which a filler is provided. It is therefore believed that these claims also clearly and patentably distinguish the present invention from the prior art represented by the patent.

It is believed that the inventive method of painting, the inventive paint, as well as the inventive method of producing of the

inventive paint are new, highly advantageous, and unobvious when compared with the coating disclosed in the patent to Pirig.

Dennis Songhurst

Dennis Songhurst

Date: April 07, 2004